

31

REMARKS

Claims 1-25, 27 and 31-36 are pending in the case. In the Final Rejection mailed on June 16, 2004, the Examiner allowed claims 31-35. Claims 1-25, 27 and 36 stand rejected.

The Examiner maintained the rejection of claims 1-25, 27 and 36 under 35 U.S.C. § 112, first paragraph, allegedly for "enablement" reasons. In this Amendment, Applicants have amended claim 1, making substantial limitations in several moieties including the central cyclic part, X, Y, R¹, R⁴, W, Q, A, E, G, J, L, M, R, R' and p. Applicants believe that there is substantial support and enablement in the specification for the amended claim 1. As part of the amendment, several dependent claims have been cancelled without prejudice or amended accordingly. Applicants would like to state that that this amendment is being done strictly for advancing the prosecution of this case and not necessarily as an admission of non-patentability. Applicants are reserving the right to continue to prosecute the cancelled claims and scope by means of divisional application(s) if Applicants choose to do so. Applicants believe that the present amendment overcomes the § 112, first paragraph rejection; withdrawal of the rejection is respectfully requested.

Claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/013,071. Applicants are enclosing a terminal disclaimer. Withdrawal of the double patenting rejection is, respectfully, requested.

Applicants respectfully request entry and favorable consideration of the present amendment. There being no other rejections pending, Applicants believe that claims 1-25, 27 and 31-36, as amended, are in allowable condition. Such an action is earnestly requested. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

June 23, 2004
Schering-Plough Corporation
Patent Department, K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, New Jersey 07033
Tel: 908-298-5068
Fax: 908-298-5388

Respectfully submitted,



Dr. Palaiyur S. Kalyanaraman
Reg. No. 34,634
Attorney for Applicants